

Application No. 10/715,367
H-7187

EXHIBIT B

Preliminary Opinion of the Opposition Division of the EPO

A. Facts and Submissions

1. European Patent EP 1489562 B1 stems from the European patent application EP03028753.6 filed on 12.12.2003 claiming priority of JP2003171476 which was filed on 17.06.2003.
 2. The mention of the grant of the European patent was published in Bulletin 2006/43 on 25.10.2006.
The title of the patent is "System and method for tracing bank notes".
The proprietor of the patent is
Hitachi-Omron Terminal Solution Corp. of Tokyo (JP).
 3. A first notice of opposition was filed on 25.7.2007 by the first opponent (Opponent 1):
Gieseke & Devrient GmbH,
Prinzregenterstr. 159, 81677 München (DE).
The notice is admissible.
- 3.1 Opponent 1 requested for the patent to be revoked in its entirety on the grounds of:
- Art. 100a EPC (Lack of Novelty and Inventive Step) and
Art. 100c EPC (Extension of the subject matter beyond the originally filed content).
- He also requested oral proceedings in case the opposition division was not going to grant his request.
- 3.2 Opponent 1 based his arguments on the following documents:
- E1: WO 01/97180 (published on 20.12.2001);
E2: EZB Rahmenvereinbarung vom 24.05.2002
(retrieved from www.ecb.int/pub/pdf/other/cashrecyclingtermsde.pdf);
E3: Prospekt zum Rückverfolgungssystem "PIDSY" von Gieseke & Devrient;
E4: EP 0744716 B1 (patent specification published on 29.12.1999);
D1: US2003/0059098 (published on 27.03.2003);

Document D1 was also cited during the examination procedure.

3.3 Opponent 1 argued lack of novelty of claims 1 in respect to E1 and D1 and of claim 11 in respect to E1. He further argued lack of inventive step of claim 1 in respect to E1, D1 and E3 and of claim 11 in respect to E2, E3, D1 and combinations thereof. He also argued that claim 1 contained subject matter beyond the originally filed content, contrary to Art. 123(2) and 100(c) EPC.

4 A second notice of opposition was filed on 25.07.2007 as well by the second opponent (Opponent 2):

Wincor Nixdorf International GmbH
Heinz-Nixdorf Ring 1, 33106 Paderborn (DE).
The notice is admissible.

4.2 Opponent 2 requested for the patent to be revoked in its entirety on the grounds of :

Art. 100a EPC (Lack of Novelty and Inventive Step) and
Art. 100c EPC (Extension of the subject matter beyond the originally filed content).

He also requested oral proceedings in case the opposition division was not going to grant his request.

4.3 Opponent 2 argued based on the following documents:

D2: ProCashIn/Signature für §36 BbankG; Version 4.0 (NT); Produktbeschreibung; December 2001;

D3: Protokollnotiz für Präsentation des SNI-Geldeinzahlungsautomaten ProCash CRS am 11.08.1999 bei der Kreissparkasse Köln, Neumarkt.

D4: Anschreiben des Zentralen Kreditausschuss Bundesverband deutscher Banken vom 20.09.1999 über den Versand des Dokumentes D3 an die Teilnehmer;

as well as document D1.

- 4.4 Opponent 2 argued that claims 1, 8 and 11 lacked novelty in respect to D2, D3 and D4. Additionally, for claim 11, D1 was also novelty destroying. He further argued that claim 1 contained subject matter going beyond the originally filed content against the requirements of Art. 123(2) and 100(c) EPC.
5. The patentee responded by filing observations, received at the EPO on 28.03.2008.
- 5.1 He requested for both oppositions to be rejected and the patent to be maintained as granted. Auxiliarily, he requested oral proceedings.
- 5.2 The patentee contested the validity of E2, E3 and D2 as prior art insofar as it was not certain when - if at all - they were made available to the public. He also argued for the novelty and inventive step of the claims as well as the fulfilment of the requirements of Art. 123(2) and 100(c) in respect to claim 1.
6. No other submissions were made by the parties.

B. Preliminary, non-binding opinion of the opposition division

7. Prior Art

- 7.1 The patentee contests the validity of documents E2, E3 and D2 as prior art in the sense of Art 54(2) EPC. In particular he raised doubts as to the date they were made available to the public.
- 7.2 Regarding document E2, the patentee states that, as it was retrieved from the Internet, there is further evidence required as to when it was exactly made available to the public. E2 is by the European Central Bank (ECB) and it is still available at the ECB's website on the date of writing this annex (12.06.2008), at the same URL Opponent 1 indicated. Furthermore, it is to be found in a section of the website containing documents the ECB identifies as having been published in 2002. The date mentioned in the end of the document is also given as publication date (24.05.2002) at the website. Given the ECB's status and reputation, the division would accept the document as being valid prior art under Art. 54(2) EPC (cf T1134/06).

7.3 Documents E3 and D2, however, would not be accepted because there are doubts about their date of becoming available to the public. E3 has no date at all on it. There is only a mention of copyright in 2003 and a piece of text "BR_PIDSY_mar03_D ZDC", which appears to be a file name. There is no other indication of when, if at all, this brochure was made available to the public. Document D2 has written on it at the bottom of every page "December 2001". There is, however, an inconsistency between the version numbers (version 3.0 at the bottom of every page vs version 4.0 in the middle of the first page) and there is no indication as to who the author/owner of this paper is. These facts raise doubts about whether the document was ever made public at all. Hence, the division would not accept E3 and D2 as part of the prior art under Art. 54(2) EPC and no argument based on those documents will be taken into account.

7.4 Document D4 states that there was a presentation of the ProCash CRS ATM by SNI on 11.08.1999. The content of the presentation is described in document D3. Since D3 was made public before the priority date of the patent and since D4 does not provide any additional evidence about the presentation, the division considers reference to D3 to be sufficient and D4 to be redundant.

8. Art. 100(c) EPC- Extension of subject matter (Art 123(2) EPC)

8.1 Opponent 1 argues that claim 1 contains features that have no basis in the content of the application as filed:

- (i) the "external station" where the bank notes are identified as counterfeit is an unacceptable generalisation of the "bank central office" mentioned in the application;
- (ii) the retrieval device being "for tracing the counterfeit banknote" is also not supported as it is evident that the whole of the claimed machine is for tracing the bank note and not only the retrieval device.

8.2 Opponent 2 identifies further features in claim 1 for which he argues there is no basis on the originally filed content of the application:

- (iii) the image extraction device being configured to extract initial images from the initial bank note and the counterfeit bank note is not supported by the description because it is stated that the image extraction device extracts initial images from the initial bank note and subsequent images of the subsequent bank note (i.e. the device makes initial images of the counterfeit bank note contrary to the content of the description);
- (iv) in combination with the previous feature, it appears that the transaction log device which is configured to attach a transaction log to one or more of the initial images, attaches a transaction log to images from the counterfeit bank note as well, something not envisaged by the application;
- (v) the comparison device which compares initial images of the initial banknote and the counterfeit bank note is not the same as the one described originally which compares images of the initial and the subsequent bank note.

8.3 Concerning feature (i) the opposition division is of the opinion that the purpose of the mention of an external station is only to state that the comparison takes place externally from the claimed ATM. Furthermore it is not a feature of the claimed ATM machine. Hence it cannot be seen as going beyond the limits of Art. 123(2) EPC.

8.4 The application states that a counterfeit bank note becomes a subsequent bank note for the rest of the procedure and that in reality it is physically the same as the initial bank note. Hence the terms subsequent and counterfeit appear to be interchangeable. Feature (v) appears, thus, to have basis in the application as originally filed.

8.5 Considering feature (ii) it is evident that the retrieval of the transaction log by the retrieval device is made for tracing the counterfeit bank note. The claim does not specify that only this device is responsible for performing the tracing. Furthermore, "for tracing" is to be interpreted as "suitable for tracing" (see Guidelines C-III 4.13) and as such it is not a limiting feature of the defined device. To the opposition division, this feature is compliant with the requirements of Art. 123(2) EPC.

8.6 Regarding features (iii) and (iv) the problem appears to originate from a syntax error

in the claim. The claim as granted states "... and image extraction device (208) configured to extract ***initial images (216) from the initial bank note (204) and the counterfeit bank note...***". From this phrase it could be understood that the device extracts ***initial images*** from the ***initial bank note*** and ***initial images*** from the ***counterfeit bank note***. This, of course is contrary to the content of the originally filed application where the device extracts ***initial images*** from the ***initial bank note*** and ***subsequent images*** from the ***subsequent (i.e. counterfeit) bank note***. When, then, the transaction log device attaches a transaction log to the initial images (feature iv), this as well could be interpreted as attaching the transaction log to the initial images of the initial or of the counterfeit bank note. To the opposition division, these two features violate Art. 123(2) EPC - even if only formally - as they introduce subject matter beyond the content of the application as originally filed.

9. Art. 100(a) - Novelty (Art 54 EPC)

9.1 The opponents argued lack of novelty for independent claim 1 in viz-à-vis documents E1, D1 and D3.

9.2 Document E1, however, states that the images of the initial bank note and the counterfeit bank note are made by different image extraction devices (see page 12, lines 6-17) and not by the same device as in claim 1.

9.3 Document D1 does not disclose the use of images for comparison. The "other data" mentioned in paragraph 0146 do not include images, according to figure 10a.

9.4 Document D3 does not disclose the use of images at all. There is a mention of a sensor (first page, second paragraph) but there is no other detail about which characteristics of the bank note it senses.

9.5 It appears, thus, that no prior art document discloses all the features of claim 1, which is thus novel.

9.6 Opponent 2 argues that claim 8 lacks novelty over document D3. D3, however, does not disclose any details over the interface of the presented ATM. Hence, to the

division is claim 8 novel as well.

9.7 Concerning claim 11, the opponents argued lack of novelty in respect to documents E1, D1, and D3.

9.8 Documents D1 and D3 do not disclose the use of images for the comparison between the initial and the counterfeit banknote (cf 9.3, 9.4 above) and claim 11 is novel in respect to them.

9.9 Document E1 discloses a method for tracing bank notes with the steps of:

- receiving a deposit of an initial bank note (eg. page 11, lines 5-8);
- extracting one or more initial images from the initial bank note (page 12, lines 7-10);
- attaching an initial transaction log to the one or more initial images (for eg. claim 13);
- receiving one or more subsequent images of a counterfeit bank note which is physically the same bank note as the initial bank note after having been identified as counterfeit bank note (page 12, lines 10-13);
- comparing the one or more initial images of the initial bank note to the one or more images of the counterfeit bank note in order to obtain a comparison result (page 12, lines 13-14);
- retrieving the initial transaction log based on the comparison result if the comparison result indicates that the one or more initial images of the initial bank note and the counterfeit bank note are within a range of similarity (page 12, lines 13-15).

9.10 The patentee stated that there is a difference between claim 11 and E1 in that in claim 1 the comparison is similarity-based whereas in E1 it is an exact match. To the opposition division, the exact match is within a range of similarity and this does not constitute a difference. Furthermore, and contrary to the patentee's arguments there is no mention in claim 11 about the device which extracts the images of the bank notes. Hence, claim 11 is not novel in when compared to E1.

10. Art. 100(a) - Inventive Step (Art 56 EPC)

- 10.1 Document D1, discloses a system for processing documents - bank notes are repeatedly mentioned in the various embodiments -using full image scanning. Despite the image extraction of the bank notes upon deposit, the system uses the image only to retrieve information such as serial numbers, signatures, bank institution etc. When the document is identified as counterfeit there is no subsequent image extraction but - as mentioned in paragraph 0145 - "the Bank A runs the serial number" through a processor...". Hence the comparison is made based on specific pieces of data (see also figure 10a) and not on images. Furthermore D1 appears to be teaching away from the invention as it is said that when there is need for more accurate results in comparison, other data can be added to the serial number such as denomination, time of deposit, signatures etc.
- 10.2 Document E2 discloses a series of requirements for cash recycling machines as published by the ECB. There are no details as to the technical structure or operation of the cash recycling machines that fulfill those requirements. The skilled person would have no indication on how to proceed and arrive at the invention.
- 10.3 Document D3 describes a presentation of an ATM. The operation of the ATM is very similar to the invention: Deposited bank notes are identified by a sensor and transaction log is associated with every deposited bank note. Bank notes that have been identified as counterfeit are re-introduced to the ATM and passed through the same sensor. The ATM searches to match the newly sensed bank notes with the originally sensed ones and when it does, the transaction log is retrieved for the depositor to be identified. What is missing from D3 are the details of the sensor and on what type of data related to the bank note the comparison and match is based on. What is the objective technical problem solved by this difference and whether its solution would be obvious to the skilled person would be discussed during the oral proceedings.
- 10.4 Document E1 describes a method of verifying the authenticity of documents, more specifically bank notes. Besides verifying the authenticity, the method of E1 performs also tracking of counterfeit bank notes (see page 12, Rückverfolgung" in line 5 ed.seq.). Images of deposited bank notes are extracted at the ATM and stored with information about the depositor (transaction log). When a bank note is

identified, at an external station, that as being counterfeit, images of it are extracted and compared with the originally extracted images in order to identify the originally deposited bank note and its depositor through the transaction log (see page 12, lines 6-18).

10.5 The difference between claim 1 and E1 is that in the ATM of claim 1 the initial and counterfeit bank note are scanned by the same image extraction device whereas in E1 the initial bank note is scanned at the "Prüfstation 30", which can be at the ATM, and the counterfeit bank note at the "zentrale Prüfeinrichtung 35" which is at the bank central office. The patentee argued that by extracting the images with the same device in both cases, same treatment of the bank note is assured and this results better comparison results.

Whether it would be obvious to the skilled person starting from E1 and trying to improve the accuracy of the comparison to modify the system of E1 and arrive at the ATM of claim 1 would be object of discussion during the oral proceedings.

10.6 Concerning the interface of claim 8, it has to be pointed out at this point that no admissible prior art document discloses any details of the interface of the described corresponding systems. The opposition division is of the opinion that the prior art documents do not give sufficient indication to the skilled person in order for him to be able to implement the interface of claim 8 without using any inventive skill.

11. Concluding remarks

11.1 Following the above, it is the preliminary opinion of the opposition division that the patent as granted may contain subject matter beyond the content of the originally filed application. Furthermore, it appears that at least claim 11 lacks novelty when compared to E1. It appears, thus, that the patent cannot be maintained as granted. Naturally, final conclusions on these issues as well as all the issues developed under sections 8, 9 and 10 will be drawn during the oral proceedings, which are hereby summoned as all parties requested for them.

11.2 Attention of the parties is drawn to the requirements of Rule 116 EPC. The final date for submissions is set to one month before the date of the oral proceedings. Parties

are advised that any submissions made after that date may not be taken into consideration by the division (Rule 116(1) EPC, last sentence).

11.3 The proprietor's attention is drawn to the requirements of Art. 123(2) and (3) EPC as well as of Rule 80 EPC concerning amendments of the patent.